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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,045	12/18/2000	Jacques Bauer	GEI-084	6820
47888	7590	08/26/2005	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			RUSSEL, JEFFREY E	
			ART UNIT	PAPER NUMBER
			1654	
DATE MAILED: 08/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

HC

Office Action Summary

Application No.

09/720,045

Applicant(s)

BAUER ET AL.

Examiner

Jeffrey E. Russel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-42 and 49-56 is/are pending in the application.
- 4a) Of the above claim(s) 54-56 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34,35,37-42 and 53 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 36 and 49-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This application is in condition for allowance except for the following formal matters:

A) The amendments to the specification filed July 14, 2005 have not been entered because they are in improper format under 37 CFR 1.121:

With respect to the amendments to the specification, the latest amendment to the brief description of the drawings to be entered was the one filed on February 5, 2004. All proposed amendments must be marked with respect to this version of the brief description of the drawings filed on February 5, 2004. Accordingly, the latest amendment to the brief description of the drawings, filed July 14, 2005, is not in compliance with 37 CFR 1.121(b)(1)(ii), because: In the brief description of Fig. 10, line 2, "of" (first occurrence) should be underlined, and the phrase "in supernatants of human dendritic cellsw culture" should not be shown at all because it was not present in the amendment filed February 5, 2004. In the brief description of Figs. 13, 14 and 15, at line 2, "a malaria antigen(" should not be shown at all because it was not present in the amendment filed February 5, 2004. In the brief description of Fig. 16, lines 1-2, "a malaria antigen(" should not be shown at all because it was not present in the amendment filed February 5, 2004. In the brief description of Figs. 17 to 20, at line 2, "a malaria antigen(" should not be shown at all because it was not present in the amendment filed February 5, 2004; and at line 3, it is improper for the word "and" to be both underlined and struck-through. In the brief description of Figs. 22 to 29, line 1, the phrase "IgG1, IgG2, Igm" should not be shown at all because it was not present in the amendment filed February 5, 2004. In the brief description of Figs. 39 to 41, "graphs of ES MS" should not be shown at all because it was not present in the amendment filed February 5, 2004. In the brief description of Fig. 42 and 43, "graphs of" should not be shown at all because it was not present in the amendment filed February 5, 2004. In the brief description

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of Figs 44 and 45, “are graphs of” should not be shown at all because it was not present in the amendment filed February 5, 2004. In the brief description of Fig. 46 and 47, “is a graph” should not be shown at all because it was not present in the amendment filed February 5, 2004.

The examiner has noted the following issues while reviewing the latest response for amendment format compliance:

In the proposed brief description of Fig. 10, line 1, “graph graphs” should be changed to “graph”.

In the proposed brief description of Fig. 10, line 2, and of Fig. 11, line 2, “predendritic” is misspelled.

The proposed brief description of Figs. 13, 14 and 15 stating that the ELISA graphs occur 2, 3, and 4 weeks after the first, second, and third immunizations will be new matter under 35 U.S.C. 132. Compare page 43, lines 1-3, of the specification.

In the proposed brief description of Figs. 17 to 20, line 1, “IFN- γ IFN” should be changed to “IFN- γ ”; and at line 3, “circumsporozoite” should be one word.

In the proposed brief description of Figs 44 and 45, “are” should be inserted after “45”.

B) Newly submitted claims 54-56 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The compounds recited in these claims are patentably distinct, in terms of structure and utility, from the N-acyl dipeptides which have been claimed and examined in this application. Applicants’ response did not indicate where the original disclosure of the invention supports the newly claimed subject matter, and did not provide any explanation as to why the new compound claims should be examined and why they were allowable over the prior art.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-56 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claims 54-56 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

C) This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reasons:

The Sequence Listing filed March 28, 2003 was not accompanied by a statement that the sequence listing includes no new matter. See 37 CFR 1.821(g).

Correction is required.

The statement filed February 5, 2004 does not satisfy the above requirement because it does not given any identifying data for the paper and computer readable forms. For example, the statement does not refer to the paper and computer readable forms filed March 28, 2003. Further, the statement that the "computer readable form diskette are identical" is unclear as to what is supposed to be identical to the computer readable form diskette.

The statement filed July 14, 2004 is identical to the one filed February 5, 2004, and therefore also does not satisfy the above requirement.

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The statement of no new matter filed February 1, 2005 does not satisfy the requirement set forth in the Office action mailed November 1, 2004, page 3, lines 6-8, because it does not given any identifying data for the paper and computer readable forms. For example, the statement does not refer to the paper and computer readable forms filed March 28, 2003.

D) The disclosure is objected to because of the following informalities: There is no Brief Description of Figures 36-47 as required by 37 CFR 1.74. The amendment to the specification contained in the response filed February 5, 2004 refers only to Figures 1-35. Appropriate correction is required.

E) Claims 36 and 49-52 are objected to because of the following informalities: At claim 36, line 9, the second comma after "atoms" should be deleted. At claim 49, line 9, the period at the end of the line should be changed back to a comma. Appropriate correction is required.

F) Claims 49-52 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 34 recites optional substituents for the R₁ and R₂ groups where the alkyl and carboxylic acids present in the optional substituents can only have from 1 to 24 carbon atoms (see claim 34, lines 6-9). However, when these optional substituents are recited in dependent claim 49, lines 7-8, no size limitations are set forth for the alkyl and carboxyl acids which can be present in the optional substituents. Accordingly, dependent claim 49 appears to be broader in scope than independent claim 34 with respect to the possible size of the optional substituents.

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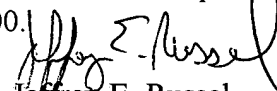
Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

2. Claims 34, 35, 37-42, and 53 are allowed. Claims 36 and 49-52 would be allowable if rewritten or amended to overcome the claim objections set forth in this Office action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (571) 273-8300; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.


Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1654

JRussel
August 22, 2005